

REMARKS

Claims 1-34 remain pending and under current examination. Applicant respectfully requests reconsideration of this application in light of the following remarks.

I. Regarding the Non-Final Office Action

In the Office Action¹, the Examiner rejected claims 1-16, 18, 19, 21 and 23-34 under 35 USC 102(b) as being anticipated by U.S. Patent No. 5,859,979 to Tung et al. ("*Tung*"); and rejected claims 17, 20, and 22 under 35 U.S.C. § 103(a) as being unpatentable over *Tung* in view of U.S. Patent No. 6,351,647 to Gustafsson ("*Gustafsson*"). Applicant respectfully traverses the Examiner's rejections for the following reasons.

II. Regarding the rejection of claims 1-16, 18, 19, 21, and 23-34 under 35 U.S.C. § 102(b) as being anticipated by *Tung*

Applicant respectfully traverses the rejection of claims 1-16, 18, 19, 21, and 23-34 under 35 U.S.C. § 102(b) as anticipated by *Tung*. In order to properly establish that *Tung* anticipates Applicant's claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Tung does not disclose each and every element of Applicant's claimed invention. Claim 1 calls for a combination including, for example, "a method for establishing communication between a first wireless terminal and a second wireless terminal" (emphasis added). *Tung* fails

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

to teach or suggest at least this element of claim 1. Although the Examiner cited *Tung*, col. 1, lines 54 to col. 2, line 9, neither this portion nor any other portion of *Tung* teaches or suggests a combination including, for example, “establishing communication between a first wireless terminal and a second wireless terminal,” (emphasis added) as recited by claim 1. Accordingly, *Tung* cannot anticipate claim 1. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the rejection of claim 1 as being anticipated by *Tung*.

Claims 2-7 depend from claim 1 and therefore include all of the elements recited therein. Therefore, claims 2-7 are allowable at least for the reasons discussed above regarding claim 1. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claims 2-7 as being anticipated by *Tung*.

Independent claim 8 recites similar elements to claim 1 and is therefore allowable at least for the reasons discussed above. Claims 9-14 depend from claim 8 and therefore include all of the elements recited therein. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of independent claims 8-14 as being anticipated by *Tung*.

Independent claims 15, 18, and 21 recite similar elements to claim 1 and therefore are allowable at least for the reasons discussed above. Additionally, claims 15, 18, and 21 recite, among other things:

receiving a call signal from the first wireless terminal to establish a video session
between the first wireless terminal and the second wireless terminal; ...
setting up a video session between the first wireless terminal and a video server;
and
setting up a non-video session between the first wireless terminal and the second
wireless terminal.

Tung does not teach or suggest at least these elements. The Examiner identifies col. 1, line 54 to col. 2, line 9 and col. 3, lines 66 to col. 4, line 25 for allegedly teaching

these elements (Office Action at pp. 6 and 7). However, the cited sections do not teach or suggest at least:

receiving a call signal from the first wireless terminal to establish a video session between the first wireless terminal and the second wireless terminal; ...
setting up a video session between the first wireless terminal and a video server;
and
setting up a non-video session between the first wireless terminal and the second wireless terminal,

as recited by claims 15, 18, and 21. For at least these additional reasons, Applicant respectfully requests the Examiner to withdraw the rejection of claims 15, 18, and 21 as being anticipated by *Tung*.

Claims 16-17, 19-20, and 22-23 depend from claims 8, 15, 18, and 21 respectively and therefore include all of the elements recited therein. Therefore, claims 16-17, 19-20, and 22-23 are allowable at least for the reasons discussed above. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claims 16-17, 19-20, and 22-23.

Independent claims 24, 33, and 34 similarly recite a “wireless system,” which is neither taught nor suggested by *Tung*. Claims 25-32 depend from claim 24 and therefore include all of the elements recited therein. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claims 24-34 as being anticipated by *Tung*.

Furthermore, Applicant respectfully reminds the Examiner of MPEP § 706, which teaches in part:

The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity.

Applicant notes that independent claims 1, 8, 15, 18, 21, and 24 contain additional distinctions therein. Applicant respectfully requests the Examiner to clearly articulate the manner in which any references allegedly teach the elements of Applicant's claims.

III. Regarding the rejection of claims 17, 20, and 22 under 35 U.S.C. § 103(a) as being unpatentable over *Tung* in view of *Gustafsson*

Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 17, 20, and 22 because a *prima facie* case of obviousness has not been established with respect to these claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness has not been established because, among other things, neither *Tung* nor *Gustafsson*, taken alone or in combination, teaches or suggests each and every element of Applicant's claims.

Claims 17, 20, and 22 depend from claims 15, 18, and 21 respectively, and therefore include all of the elements recited therein. As noted above, *Tung* fails to teach or suggest at least

receiving a call signal from the first wireless terminal to establish a video session between the first wireless terminal and the second wireless terminal; ...
setting up a video session between the first wireless terminal and a video server;
and
setting up a non-video session between the first wireless terminal and the second wireless terminal,

as recited by claims 15, 18, and 21 and required by claims 17, 20, and 22.

Gustafsson fails to make up for the deficiencies of *Tung* discussed above. *Gustafsson* is relied upon for allegedly teaching “the database is at least one of a home location register and a visitor location register and wherein the at least one call processing module is resident in the at least one mobile switching center (col.2, lines 65 to col. 3, line 19)” (Office Action at p. 11). Even assuming the Examiner’s assertion is true, *Gustafsson* nevertheless fails to teach or suggest at least

receiving a call signal from the first wireless terminal to establish a video session
between the first wireless terminal and the second wireless terminal; ...
setting up a video session between the first wireless terminal and a video server;
and
setting up a non-video session between the first wireless terminal and the second
wireless terminal,

as required by claims 17, 20, and 22.

Because *Tung* and *Gustafsson*, taken alone or in combination, fail to teach or suggest each and every element required by claims 17, 20, and 21, no *prima facie* case of obviousness has been established for these claims. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claims 17, 20, and 21 as being unpatentable over *Tung* in view of *Gustafsson*.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

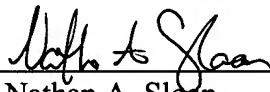
Customer No. 22,852
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Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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